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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,267	08/16/2001	Clinton C.S. Chapple	N1422-005	1973

32905 7590 10/22/2002

JONDLE & ASSOCIATES P.C.
9085 EAST MINERAL CIRCLE
SUITE 200
CENTENNIAL, CO 80112

EXAMINER

KALLIS, RUSSELL

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 10/22/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/31/267

Applicant(s)

Chapple et al

Examiner

Kallio

Group Art Unit

1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

P r i d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -1- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 8/20/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-26 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-26 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

P r i r i t y under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 8, 14-19, 23 and 25 drawn to a method of altering lignin content or composition in a plant, classified in class 800, subclass 279 for example.
- II. Claims 2, 9, 14-19, 23 and 25 drawn to a method of increasing flavonoid content in a plant, classified in class 800, subclass 285 for example.
- III. Claims 3, 10, 14-19, 23 and 25 drawn to a method of increasing isoflavonoid content in a plant, classified in class 800, subclass 289 for example.
- IV. Claims 4, 11, 14-19, 23 and 25 drawn to a method of increasing anthocyanin content in a plant, classified in class 800, subclass 282 for example.
- V. Claims 5-6, 12, 14-19, 23 and 25 drawn to a method of decreasing cell wall bound conjugates in a plant, classified in class 800, subclass 290 for example.
- VI. Claims 7 and 13-21, 23 and 25, drawn to a method of altering phenylpropanoid metabolism in a plant, classified in class 800, subclass 281 for example.
- VII. Claim 22, drawn to a polypeptide, classified in class 530, subclass 350 for example.
- VIII. Claim 24, drawn to a method of producing a polypeptide, classified in class 435, subclass 71.1 for example.
- IX. Claim 26, drawn to a mutant plant, classified in class 800, subclass 276 for example.

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Inventions I-V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are the methods of altering lignin content or composition, increasing flavonoid content, increasing isoflavonoid content, increasing anthocyanin content, decreasing cell wall bound conjugates, and altering phenylpropanoid metabolism in a plant of Groups I-VI have different effects and phenotype, and would require different method steps for evaluating each divergent phenotype.

Inventions I-VI, VII, VIII and IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different nucleic acids and plant transformation methods of Groups I-VI, the isolated polypeptide of Group VII, the transformed microbial cell of Group VIII and the mutant plant of Group IX either have different compositions, structure, or function.

Claims 14-19, 23 and 25 will be examined to the extent they read upon the elected invention of either group I-V or VI.

Upon election of Group I-V or VI, Applicant is additionally required to elect SEQ ID NOs: 1, 4, and 6; or a nucleic acid encoding SEQ ID NOs: 2, 5, and 7. This requirement is not to be construed as a requirement for an election of species, since each of the nucleic acid sequences or amino acid sequences recited in alternative form is not a member of a single structurally related genus, but rather constitutes an independent and patentably distinct invention. Separate

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searches and considerations would be required for examination of each of the nucleic acid sequences or amino acid sequences.

Inventions VII and VIII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the isolated polypeptide of Group VII can be made by a method other than the recombinant method of transformation and expression of a microbial cell of Group VIII, such as isolation from a native organism or chemical synthesis.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and because the search required for one of the groups is not required for another, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (703) 305-5417. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone number for this Group is (703) 308-4242 or (703) 305-3014.

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Any inquiry of a general nature or relating to the status of this application, or if the examiner cannot be reached as indicated above, should be directed to the patent analyst, Gwendolyn Payne, whose telephone number is (703) 305-2475.

Russell Kallis, Ph.D.
10/15/2002

DAVID T. FOX
PRIMARY EXAMINER
GROUP 1807/1638

A large, stylized handwritten signature in black ink, likely belonging to David T. Fox, the primary examiner mentioned in the stamp above.